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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
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09/076,404

05/12/1998

DAVID J. ECKER

IBIS-0007US

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02/04/2009

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EXAMINER

BRUSCA, JOHN S

ART UNIT

PAPER NUMBER

1631

MAIL DATE

DELIVERY MODE

02/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|--|--------------------------------------|-------------------------------------|--|
| <p align="center">Advisory Action Before the Filing of an Appeal Brief</p> | Application No. 09/076,404 | Applicant(s) ECKER ET AL. | |
| | Examiner John S. Brusca | Art Unit 1631 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 January 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: 19,20,26,30,32-35,37,38,40,41,43,44,46 and 47.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). filed 14 January 2009
13. ☒ Other: See Continuation Sheet.

/John S. Brusca/
Primary Examiner, Art Unit 1631

Continuation of 11. does NOT place the application in condition for allowance because: The applicants state that a human target RNA with a molecular interaction site of less than 30 nucleotides is described, but fail to point to anything more than a recitation of the genus in the specification. To describe the claimed genus, the specification must provide structures or other relevant identifying characteristics of a representative number of species of the claimed genus, as discussed in the Office action mailed 17 November 2008. The applicants point to figures 40-44 and examples 13-16, however the figures and examples do not state the RNA is human in origin, and it is apparent from the description of the RNA as a 16srRNA that the RNA is bacterial in origin. The applicants point to example 12, however the example discusses HIV RNA rather than the claimed human RNA. The applicants state that combining in silico screening of Sezerman et al. with the mass spectrometry method of Greig et al. is not obvious because each reference uses different methods to determining binding. Both Sezerman et al. and Greig et al. show methods of determining binding strength and it would be obvious to use both methods because the prior art shows that each method could be expected to produce a useful measure of binding. The applicants state that Hentze et al. does not compare in silico RNA structures from different taxonomic species. Figure 2 of Hentze et al. shows results of a computer modeled comparison of human, rat, bullfrog, and chicken H chains, which shows the claimed limitation.

Continuation of 13. Other: The information disclosure statement filed 14 January 2009 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered. It is further noted that the cited application number 09/076,404 is the instant application number. In the Information Disclosure Statement filed 03 January 2008, the applicants listed a different application No. 09/076,447, which was not considered because no copy was provided and the application was not in IFW electronic files. The applicants stated in the after final response filed 14 January 2009 that the applicants have filed an electronic copy of USSN 09/076,447 which was listed in a previously filed Information Disclosure Statement. The application copy that accompanied the response of 14 January 2009 does not have an application number, and lists an attorney docket number of IBIS 0002 and inventorship of Ecker, Sampath, and Griffey. A review of the bibliographic data for Application No. 09/076447 shows that the attorney docket number is IBIS 0004 and the inventorship is Griffey and Mohan. Both applications were filed on 12 May 1998. Therefore the application number of the reference that accompanied the after final response filed 14 January 2009 is not the asserted 09/076447, and the true application number is not provided by the applicants. The reference has been placed in the application file but has not been considered..